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09/514,352	02/28/2000	Gunji Tsukuda	NIT-84-02	8320

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EXAMINER

PATEL, JAGDISH

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 07/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/514,352

Applicant(s)

TSUKUDA, GUNJI

Examiner

JAGDISH N PATEL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 4/30/03.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,22-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,22-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. This communication is in response to amendment filed 4/30/03.

***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/27/03 has been entered.

***Response to Amendment***

3. Claims 1, 2, 4, 22, 24, 26-29, 31, 37-39, 41, 44 and 46 have been amended per request.
4. claims 48-51 have been canceled.
5. claims 1, 2, 4 and 22-47 are currently pending and have been examined.
6. PTO-1449 forms have been initialed and returned herewith.

***Response to Arguments***

7. Applicant's arguments, see REMARKS pp. 15-21, filed 4/30/03, with respect to examiner's objection to claim 4, objection to the specification, corresponding rejection of claims 22-51 under 35 U.S.C. § 112, first paragraph, and rejection of claims 2, 4 and 22-51 under 35 U.S.C. §102 and 103 have been fully considered and are persuasive. The aforementioned rejections and objections of specification and claims have been accordingly withdrawn.

***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

9. Claims 31-40 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof" (emphasis added). Applicant's claims mentioned above are intended to embrace or overlap two different statutory classes of invention as set forth in 35 USC 101. The

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claims begin by discussing a method (ex. preamble of claim 31), the body of the claim discusses the specifics of the system of managing delivery, and subsequently the claim then deals with the specifics of a method (the steps) executed by distribution server (see above rejection of claims under 35 USC 112, second paragraph, for specific details regarding this issue). "A claim of this type is precluded by the express language of 35 USC 101 which is drafted so as to set forth the statutory classes of invention in the alternative only", Ex parte Lyell (17 USPQ2d 1548).

[the examiner suggests rewriting the system elements of claim 31 as:

providing a client apparatus...;

etc. etc.

programming said distribution server to perform the following steps:

etc. etc.].

### ***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the second paragraph of 35

U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and

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distinctly claim the subject matter which applicant regards as the invention.

Claim 1: recites an apparatus in a means plus function format. It defines means plus inputting.. and means for managing delivery.. Claim 1 recites defines functionality of delivery means as "wherein the delivery managing means sets the date and time for its delivery operation to the receiver in the case the schedule information indicates delivery time of the delivery goods to the receiver, and outputs the delivery goods information of the delivery goods to the agent in case the schedule information indicates to commit receiving the delivery goods to the agent".

The usage of phrase "in case" in the aforementioned limitation renders the claim indefinite because the scope of the claimed invention thus recited cannot be ascertained definitively due "conditional" nature of the functionality recited.

The examiner interprets the claim without the conditional phrases in it (i.e. by omitting "in the case ... the receiver" and "in the case ..the agent").

12. Similar deficiency is also present in claim 22 which recites on p. 5 line "an agent server to be used when commission by an agent is selected on delivery of goods, .... ". This is

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"conditional" recitation of the agent server which renders the scope of the claim indefinite.

Dependent claims 23-30 also inherit deficiency of parent claim 22.

13. Similar deficiency is also present in claim 31 (see line 7 of the claim) and claim 41 (see line 8 of the claim).

Dependent claims 32-40 and 42-47 also inherit deficiency of respective parent claims 31 and 41.

14. Claim 2: "means for notifying .." has no structural relationship with any other element of the claim. Therefore, it is unclear as to how it's functionality may be accomplished. This deficiency also renders the claim indefinite.

15. Claim 4 recites in the preamble entities "a distribution center", "an agent" and "a receiver". However, the claim limitations refer to "a distribution server", "an agent server" and "a client" without defining correlation amongst the respective entities. Thus, it is not clear if the objective set forth in the preamble is achieved by the limitation of the claim which the applicant regards as invention.

16. Claim 4, furthermore, fails to recite any structural relationship of any of the "means for requesting", "means for

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receiving", "means for processing", "means for determining" and "means for notifying" to any of the other elements of the system ("a distribution server" or "an agent server").

17. Claim 31 is not sufficiently precise due to the combining of two separate statutory classes of invention in a single claim. The preamble of the claim refers to a method, but the body of the claim discusses the specifics of the system for managing delivery of goods (ex. A client apparatus, a distribution server, an agent server ), and subsequently the claim then deals with the specifics of a method (the steps ex. receiving, processing, notifying and transmitting) executed by the distribution server.

18. Claims 32-40 are rejected as being dependent on claim 30 as discussed above.

19. Claim 41: The claim pertains to a distribution server for use in delivery managing system. However, the limitations include "a client apparatus", "a distribution server" and "an agent server. Thus there is inconsistency between the preamble and the limitations of the claim. It is suggested that the preamble be changed to read "A system delivery managing system for managing delivery of goods..".

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20. Claim 2 recites the limitation "the delivery goods information" and "the agent designated" in "means in the distribution server". Furthermore claim 2 recites the limitation "means for notifying of arrival and departure of the delivery goods to and from the agent", however, no information indicating arrival and departure (*information*) of the delivery goods is generated in the delivery managing system as claimed.

21. Claim 2 recites limitation "the client" in line 9 on p.3. Claim 22 recites, on p.5 lines 15-16, limitation "information for delivery of said goods to said agent", On p.5 lines 18-19 limitation " information indicative delivery of said goods" and On p.5 lines 23- p. 6 line 1, limitation "information transmitted to said agent server and said information received by inputting in the client(*apparatus?*)" .

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There is insufficient antecedent basis for these limitation(s) in the claim (s).

[Examiner's Note: The applicant is requested to thoroughly and carefully review all claims (including all dependent claims) for any deficiency of similar nature as has been presented in the above discussion]

*Claim Rejections - 35 USC § 102*

22. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

23. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Martin (US Pat. 5,960, 408).

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Per claim 1, Martin discloses a distribution server for managing delivery of delivery goods from a distribution center to a receiver, comprising:

Means for inputting schedule information of the receiver (customer order entry includes customer preferred ship date, abstract);

Means for managing delivery of the delivery goods on the basis of the said scheduled information inputted (refer to the on-time delivery tracking and reporting computer system, described in Detailed Description of the Preferred Embodiment);

Wherein the delivery managing means sets date and time sets the date and the time for its delivery operation to the receiver...(col. 3 L 34-61, the resulting customer-preferred ship date..)

#### ***Conclusion***

24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jagdish Patel whose telephone number is (703) 308-7837. The examiner can normally be reached Monday-Thursday from 8:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be

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reached at (703) 308-1038. The fax number for Formal or Official faxes to Technology Center 3600 is (703) 305-7687. **Draft faxes may be submitted directly to the examiner at (703) 746-5563.**

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113 or 308-1114. Address for hand delivery is 2451 Crystal Drive, Crystal Park 5, 7<sup>th</sup> Floor, Alexandria VA 22202.



Jagdish N. Patel

(Examiner, AU 3624)

7/23/03